

REMARKS

Summary of Restriction and Election of Species Requirement

Claims 1-7, 9 and 21-26 are pending in the application. The Office Action requires election of one of the following inventions:

- Group I Claims 1-7 and 9, drawn to class 564 and subclass 32;
- Group II Claims 21-23, drawn to class 564 and subclass 61; or
- Group III Claims 24-26, drawn to class 514 and subclass 886.

The Examiner also requires species elections of a “single compound” disclosed in the examples for group I, a “single species” and “one specific process” for group II and “a single species” and “one method of treatment” for Group III.

Applicants’ Reply to Restriction Requirement

Applicants elect the invention of Group I (claims 1-7 and 9) with traverse.

The Examiner alleges:

the search report indicates lack of unity of invention and states that claim 1 is obviated by Gagliardi et al (See: Cancer Chemother. Pharmacol. (1998) 41:117-124) and thus claim 1 lacks [a] special technical feature that binds all the claims together.

The International Search Report (ISR) and International Preliminary Examination Report (IPER) to PCT/EP03/13453 (of which the present application is a §371 national phase application) are attached as Exhibits A and B to this response. Contrary to the Examiner’s assertion, neither the ISR nor the IPER indicates that unity of invention is lacking.

The ISR and IPER also do not cite Gagliardi. Gagliardi does not disclose or suggest the compounds of claim 1. Gagliardi discloses polyanionic analogs of suramin

purportedly useful to inhibit angiogenesis; Giglaridi is not relevant to either the structure or activity of the compounds of claim 1.

Contrary to the Examiner's assertion, the ISR and IPER support examining the entire application. The IPER concludes:

that the invention as defined by the independent claims . . .
appears to be novel, to involve an inventive step and to be
industrially applicable

The ISR cites only "A" references, which indicates that the cited documents merely define the general state of the art but are not considered to be of particular relevance. The Examiner's reliance on "the search report" does not indicate the lack of at least one special technical feature. To the contrary, the ISR and IPER indicate that the claims are unified at least by the presence of the compounds encompassed by claim 1, as each pending claim calls for such a compound (or a method of using a compound encompassed by claim 1) and each claim was found to be novel and inventive. (See MPEP §1850 (II) "Whether or not any particular technical feature makes a "contribution" over the prior art and therefore constitutes a "special technical feature", should be considered with respect to novelty and inventive step.")

Furthermore, examination of all the claims would not result in a serious burden to the examiner. Each pending claim depends (either directly or indirectly) from claim 1. Due to applicant's provisional election, claim 1 will be searched in any event. A search for art relevant to claim 1 will uncover all of the relevant art for the rest of the claims. If claim 1 is found allowable over the prior art -- as found by the International Searching Authority -- then the remaining claims should also be found to allowable over the prior art. As only 14 claims are currently pending, Applicants respectfully submit that examination of these 14 claims (all of which contain the limitations of claim 1) would not be an undue burden on the Examiner.

Lastly, examination of all of the claims in this application may facilitate the expressed desire of the Commissioner to reduce the number of continuing applications currently pending within the United States Patent Office.

Due to the reasons set forth above, applicant respectfully request that Groups II and III be examined along with group I.

Applicant's Reply to Election of Species Requirement

Applicants also provisionally elect the compound of Example 1-7 (N-(7-hydroxy-5,6,7,8-tetrahydronaphthalen-1-yl)-N'-[4'-(trifluoromethyl)-biphenyl-3-yl]urea) in response to the Examiner's election of species requirement within Group I.

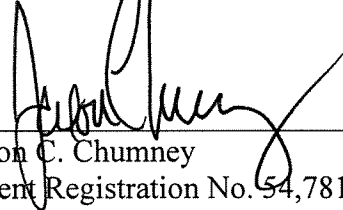
In response to the election of species requirements within groups II and III, applicants also elect (N-(7-hydroxy-5,6,7,8-tetrahydronaphthalen-1-yl)-N'-[4'-(trifluoromethyl)-biphenyl-3-yl]urea) as the "single species", a method of controlling a urological disorder or disease as the "specific process" within group II and a method of treating an overactive bladder as the "one method of treatment" within group III.

Conclusion

Applicants submit that all the provisions elections made herein are solely to be responsive to the outstanding Office Action and without prejudice to the prosecution of the subject matter of non-elected claims in divisional, continuation, and continuation-in-part applications. Also, applicants reserve the right to petition the Examiner under 37 CFR §1.132 in the event that the restriction requirement is not withdrawn.

Applicants believe that only a one-month extension fee is due in connection with this submission. If any additional fee is due, the Commissioner is authorized to charge any such fee to our Deposit Account No. 02-4377.

Respectfully submitted,



Jason C. Chumney
Patent Registration No. 54,781

Attorney for Applicant
Telephone: 212-408-2500

Baker Botts L.L.P.
30 Rockefeller Center
New York, NY 10112